

### **Remarks**

In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in the instant Office Action unless Applicant expressly indicates otherwise.

The non-final Office Action dated May 16, 2008 lists the following objections and rejections: an objection to the drawings, an objection to the title of the invention, and a suggestion to add section headings to the specification; claims 1-15 stand rejected under 35 U.S.C. § 112(2); and claims 1-15 stand rejected under 35 U.S.C. § 102(e) over Leydier *et al.* (U.S. Patent Pub. No. 2004/0148539).

Applicant respectfully traverses the objection to the drawings because the Office Action fails to identify any authority that supports the erroneous assertion that additional text labels are required for the elements in Figures 1-3. The boxes in Figures 1-3 are already labeled with reference numbers, which are described in detail in Applicant's specification. Thus, Applicant submits that the boxes in the drawings are labeled as required. *See, e.g.*, M.P.E.P. § 608.02(b). Accordingly, additional text labels are unnecessary and not required. In an effort to facilitate prosecution, Applicant has attached two replacement drawing sheets, as indicated on page 2 of this paper, in which the boxes in Figures 1-3 are provided with text labels.

Applicant respectfully traverses the objection to the title of the invention because Applicant's title is descriptive of the claimed invention. According to M.P.E.P. § 606, the title "must be as short and specific as possible". Applicant submits that the title ("Interface Integrated Circuit Device for a USB Connection") is clearly indicative of the invention to which the claims are directed and commensurate with M.P.E.P. §§ 606 and 606.01. That is, in accordance with M.P.E.P. § 606, the title recites a type of device (an interface IC) for a USB connection while also being "as short ... as possible" (specified by M.P.E.P. § 606). Thus, Applicant submits that the title of the invention is appropriate and Applicant requests that the objection thereto be removed.

Regarding the Office Action's suggestion to add headings to the specification, Applicant respectfully declines because the indicated suggestions in 37 C.F.R. § 1.77(b) are not statutorily required for filing a non-provisional patent application under 35 USC § 111(a), but per 37 C.F.R. § 1.51(d) are only guidelines that are suggested for applicant's use. They are not mandatory, and in fact when Rule 77 was amended in 1996 (61 FR

42790, Aug. 19, 1996), Bruce A. Lehman, Assistant Secretary of Commerce and Commissioner of Patents and Trademarks, stated in the Official Gazette:

“Section 1.77 is permissive rather than mandatory. ... 1.77 merely expresses the Office's preference for the arrangement of the application elements. The Office may advise an applicant that the application does not comply with the format set forth in 1.77, and suggest this format for the applicant's consideration; however, the Office will not require any application to comply with the format set forth in 1.77.”

In view of the above, Applicant prefers not to add section headings and Applicant requests that the objection to the specification be withdrawn.

Applicant respectfully traverses the § 112(2) rejections of claims 1-15 because the claims do particularly point out and distinctly claim that which Applicant regards as the invention. The Office Action identifies four separate issues listed under heading a-d, each of which are addressed in the following discussion.

Regarding the § 112(2) rejection listed under item a, the Office Action asserts that the claims are indefinite because the structural relations between various elements are missing. It appears to Applicant that the Office Action has not asserted that any specific claim language is indefinite, but rather that limitations be inserted in order to address ancillary issues such as to define “structural relations between these elements”. Applicant submits that it appears that the Office Action is attempting to limit the breadth of the claims by improperly asserting indefiniteness because the claims are not worded as the Office Action would prefer. Such an assertion is contrary to M.P.E.P. § 2173.04 because the “(b)readth of a claim is not to be equated with indefiniteness.” *See In re Miller*, 441 F.2d 689 (CCPA 1971). The scope of the claims would be clear to one of skill in the art based on Applicant's disclosure (*see, e.g.*, Figure 1), thus the claims are definite. *See, e.g.*, M.P.E.P. § 2171. Accordingly, this Section 112(2) rejection is improper and Applicant requests that it be withdrawn.

Regarding the § 112(2) rejection listed under item b, the Office Action asks for clarification concerning the first, second and third external terminals of claim 1. Applicant submits that it would be clear to the skilled artisan that the claimed interface integrated circuit includes first, second and third external terminals (*see, e.g.*, Figure 1). For example, it would be clear to the skilled artisan that the first, second and third external terminals can be used to couple the interface integrated circuit to objects that are

external to (*i.e.*, not part of) the interface integrated circuit. Applicant submits that it appears that the Office Action is again attempting to limit the breadth of the claims by improperly asserting indefiniteness. *See, e.g.*, M.P.E.P. § 2173.04 discussed above. Accordingly, this § 112(2) rejection is improper and Applicant requests that it be withdrawn. In an effort to facilitate prosecution, Applicant has amended claims 1, 3 and 5 to remove the external wording and limitations in relation to the terminals.

Regarding the § 112(2) rejection listed under item c, Applicant has amended each of the independent claims to spell out the acronym USB in the first occurrence in each of these claims. Accordingly, Applicant requests that this § 112(2) rejection be withdrawn.

Regarding the § 112(2) rejection of claim 2 listed under item d, the Office Action requests clarification concerning lines 3-4 of claim 2 which read in part “for connection to an external USB device without and with an external transceiver”. Applicant submits that claim 2 in its entirety, which recites “the device interface comprises both an analog USB device interface and a transceived digital USB device interface for connection to an external USB device controller without and with an external transceiver, respectively”, would be clear to the skilled artisan. For example, it would be clear to the skilled artisan that the device interface includes an analog USB device interface for connection to an external USB device controller without an external transceiver and that the device interface includes a transceived digital USB device for connection to an external USB device controller with an external transceiver. Accordingly, this § 112(2) rejection is improper and Applicant requests that it be withdrawn.

In view of the above, Applicant submits that each of the § 112(2) rejections has been addressed and overcome. Thus, Applicant requests that the § 112(2) rejections of claims 1-15 be withdrawn.

Applicant respectfully traverses the § 102(e) rejection of claims 1-15 because the Leydier reference is not prior art to the claimed invention. Applicant’s priority date is September 24, 2002 via Application No. SG02/00240. Applicant claimed priority to Application No. SG02/00240 on the Combined Declaration For Patent Application And Power of Attorney filed on March 21, 2005 accompanying the instant application and Applicant also filed on March 21, 2005 a certified English copy of Application No. SG02/00240 concurrently therewith. Thus, Applicant submits that the priority claim of

the instant application to Application No. SG02/00240 has been perfected and Applicant requests that this prior claim be recognized. *See, e.g.*, 37 CFR 1.55 and M.P.E.P.

§ 201.14. The filing date of the Leydier reference is January 28, 2003, which is after Applicant's priority date of September 24, 2002. Thus, the Leydier reference is not prior art (*e.g.*, under § 102(e)) to the claimed invention. Accordingly, the § 102(e) rejection of claims 1-15 is improper and Applicant requests that it be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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Attachments: Two Replacement Drawing Sheets